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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,879	06/29/2001	Paul Glatkowski	8125.002.CNUS	4705
69911	7590	07/17/2007		
JAMES REMENICK NOVAK DRUCE & QUIGG, LLP 1300 I STREET NW SUITE 1000 WEST TOWER WASHINGTON, DC 20005			EXAMINER YOON, TAE H	
			ART UNIT	PAPER NUMBER
			1714	
			MAIL DATE	DELIVERY MODE
			07/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	09/894,879	GLATKOWSKI ET AL.	
	Examiner	Art Unit	
	Tae H. Yoon	1714	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 July 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 23-49, 52-54 and 76-122.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.



Tae H Yoon
Primary Examiner
Art Unit: 1714

ATTACHMENT TO ADVISORY ACTION

The NEW MATTER rejection is maintained for reason of record with following response.

Applicant trying to pass the burden to the examiner stating that Examiner's Affidavit would be needed in order to maintain the rejection, but applicant has an initial burden to show or disclose that the **plane wave shielding effectiveness (SE_{pw})** and the **magnetic wave shielding effectiveness (SE_m)** are same. However, applicant's own statement, **[P]lane wave shielding and magnetic wave shielding are closely related properties of shielding**, supports the examiner's position since applicant failed to state that the plane wave shielding and magnetic wave shielding are same (applicant states **closely related properties of shielding**). Also, notes that there is no teaching with respect to how they are related each other either. Also, the recited enhancement of at least 10 dB, for example, does not have support contrary to applicant's assertion since said at least 10 dB must include 10 dB and since choosing a particular value must be based on the disclosed values. See *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976).

Also, again, the limitation recited claim 42 does not have support in specification (pointed out by applicant) wherein the recited **combined limitation**, "carbon nanotubes that are substantially not in contact with each other, other than their longitudinal areas" and "other than their longitudinal areas and are not aligned or oriented to provide electromagnetic shielding" cannot be found in locations pointed out by applicant. Contrary to applicant's assertion, a different context or description is recited.

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Claims 23-49, 52-54 and 76-103 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the composite of PET and nanotubes having an enhanced electromagnetic shielding, does not reasonably provide enablement for the recited composite. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

Notes that the examiner does not question a polymer matrix (PET) per se, but a total composition. A polymer as well as other critical parameters such as wt%, elongation ratio and particular frequencies such as 20 KHz and 0.2 GHz would have effect on electromagnetic shielding effectiveness. Said wt%, elongation ratio and particular frequencies when combined with a particular polymer would change electromagnetic shielding effectiveness of the polymer. Notes that applicant failed to show an enhancement of at least 5 dB for polymers with other critical parameters such as wt%, elongation ratio and particular frequencies other than PET in examples.

Claims 23-49, 52-54, 76-103, 104 and 108-122 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Smalley et al (US 6,683,783).

Rejection is maintained for reason of record with following response. Applicant failed to show the article of Smalley et al does not yield electromagnetic shielding property.

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Claims 23-49, 52-54 and 76-122 are rejected under 35 U.S.C. 103(a) as obvious over Smalley et al (US 6,683,783) and Shibuta et al (US 5,908,585).

Rejection is maintained for reason of record with above and following response.

The instantly claimed language (comprising) permits the presence of other material such as metal Shibuta et al, even in a major amount. Furthermore, Shibuta et al are cited show that use of carbon nanotubes in shielding electromagnetic waves is well known practice in the art.

Again, applicant asserts that the examiner has conceded that Smalley et al does not disclose or suggest applicant's claimed invention during the interview held on January 31, 2006, but it is not true since the examiner has stated that applicant is considering claim language option which may also overcome Smalley et al and applicant failed to do so.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Tae H Yoon
Primary Examiner
Art Unit 1714

THY/July 12, 2007